

REMARKS

This responds to the Final Office Action dated June 29, 2011.

Claims 151-152, 154-158, 162-166, 170-171, 173-177 and 181-185 are amended, no claims are canceled, and no claims are added; as a result, claims 151-188 are pending in this application.

Claim Objections

Claims 154-158, 162-166, 173-177 and 181-185 are objected to, since "corresponding" needs to be replaced with -- corresponds --, to provide for proper grammar. Appropriate correction is provided in this response to the Office Action. The Applicant respectfully requests withdrawal of the claim objections.

Information Disclosure Statement

The Examiner acknowledged receipt of Applicant's information disclosure statement, received 24 March 2011, with accompanying reference copies. The Examiner further noted that the citations of Office Actions and Applicants' responses from related application prosecution histories have been considered, but are lined through on the PTO-1449 form, because they are allegedly not considered "prior art", and as such should not print on the cover sheet of any patent that may issue from this application.

Regarding the Examiner's decision to not accept all of the references provided in the Applicant's information disclosure statement, received 24 March 2011, together with the Examiner's comment that, "the citations of Office Actions and Applicants' responses from related application prosecution histories ... are not considered 'prior art'", Applicant notes that the decision in McKesson Information Solutions, Inc. vs. Bridge Medical, Inc., 487 F.3d 897 (Fed. Cir. 2007), has essentially put all Applicants and their Representatives on notice that submission of the prosecution history in matters which appear to be related is now considered part of the duty of disclosure under 37 CFR 1.56 when such prosecution history may be relevant to examination of the claims of the current application. Applicant respectfully requests that the Examiner review the decision in McKesson, reconsider the matter, and enter the references previously submitted in the Applicant's information disclosure statement, received 24 March

2011. (See also MPEP 2004 "Aids to Compliance with Duty of Disclosure" and *Dayco Prod., Inc. v. Total Containment, Inc.*, 329 F.2d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003)).

Double Patenting Rejection

Claims 151 and 152 are rejected on the ground of non-statutory double patenting over claim 14 of U.S. Patent No. 5,845,281 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Claims 170 and 171 are rejected on the ground of non-statutory double patenting over claim 14 of U.S. Patent No. 5,845,281 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Claim 152 is provisionally rejected on the ground of non-statutory double patenting over claim 54 of co-pending Application Serial No. 09/164,606. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Claims 170 and 171 are provisionally rejected on the ground of non-statutory double patenting over claim 54 of co-pending Application Serial No. 09/164,606. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Applicant does not admit that claims are obvious in view of U.S. Patent No. 5,845,281. Nevertheless, a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b) is being submitted to obviate this rejection. Applicant does not admit that claims are obvious in view of co-pending Application Serial No. 09/164,606. Nevertheless, a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b) will be submitted in due course to obviate this provisional rejection. The Applicant respectfully requests withdrawal of the double patenting rejections.

The Rejection of Claims Under § 101

Claim 151 is provisionally rejected under 35 U.S.C. § 101, as allegedly claiming the same invention as that of claim 54 of co-pending Application Serial No. 09/164,606. Claim 54 of co-pending Application Serial No. 09/164,606 is being amended as follows:

54. The method of Claim 52, additionally comprising A method of controlling the usage by a user of data objects so as to comply with a variable number of conditions for usage of the data objects, comprising:

providing at least two data packages, each data package comprising a data object and a user set of control data, which comprises at least one usage control element defining a usage of the data object which complies with the variable number of conditions, the data object and the user set of control data for each data package being encrypted;

decrypting the user set of control data for each data package;

examining the usage control elements of the at least two data packages to find a match;

checking whether a data processor is capable of executing a security procedure specified in a security control element of the at least one usage control element, and disabling the usage when the data processor is not capable of executing the security procedure; and

performing an action being specified in the user sets of control data of the at least two data packages.

Note that the language of co-pending amended claim 54 differs from the language of claim 151 of the present application. In particular, the amended claim 54 recites, “the data object and the user set of control data for each data package being encrypted” and “decrypting the user set of control data for each data package”, whereas claim 151 of the present application recites, “the data object and the usage control element for each data package being encrypted” and “decrypting the usage control elements of the sets of control data.” As such, claims 54 and 151 are claiming different subject matter. Therefore, the Applicant respectfully submits that claims 54 and 151 are not claiming the same invention. The Applicant requests withdrawal of the provisional rejection under §101.

Allowable Subject Matter

Claims 153-169 and 172-188 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Given the amendments and arguments submitted herein, the Applicant respectfully submits that claims 151, 152, 170, and 171 are allowable for

the reasons explained herein. As such, claims 153-169 and 172-188 are dependent upon allowable base claims. The Applicant respectfully requests allowance of the pending claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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By



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